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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,153	08/21/2003	Michael Delancy	83336.1535	7182

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STEPTOE & JOHNSON, LLP
2121 AVENUE OF THE STARS
SUITE 2800
LOS ANGELES, CA 90067

EXAMINER	
DEODHAR, OMKAR A	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
01/22/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kstowe@steptoe.com
emiyake@steptoe.com
jpcody@ballytech.com

Office Action Summary	Application No.	Applicant(s)	
	10/645,153	DELANEY ET AL.	
	Examiner	Art Unit	
	OMKAR A. DEODHAR	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Final Rejection

Response to Amendment & Arguments

Applicant's amendment overcomes the claim objections.

The basic concept taught by Tulley is that predetermined outcomes (wins & losses) are revealed via games (slots, video poker) displayed on a player terminal. Applicant's invention appears to do the same, but with the exception that the games include bonus rounds not requiring additional wagers.

Applicant argues that Nicastro fails to teach a base game play result & a bonus game play result determined from a single game play result. As acknowledged by Applicant, Nicastro was relied upon for teaching:

"Those skilled in the art will appreciate that many variations on the basic game and bonus game describe herein are possible in keeping with the spirit and scope of the present invention. The particular graphical elements can be arranged differently or have a different appearance. The overall game theme can be a different, such as hound and hare rather than cat and mouse. **The basic game can be any video game offering a winning combination that earns a bonus game entry combination, such as a video slot machine game**, video poker, video blackjack, video keno, or the like." Nicastro, Paragraph 85.

The portion in bold lettering teaches precisely that which Applicant alleges to be lacking. There is a basic game with an outcome & the basic game may result in a bonus game.

Applicant argues "player skill and/or decisions used to determine a bonus game outcome is inconsistent with a game in which base game & bonus games are determined from a single game play result". This argument is not persuasive. If a player puts in a coin & pulls a lever, has that player not made a decision to put in a coin & pull a lever? If that pull results in an outcome & entry into a bonus round, is it not determined from the same game? The player made the decision to activate the game by pulling the lever.

Comment [CBC31]: This won't do. This is not the type of decision he's talking about and you know it. You may not deliberately misconstrue applicant's arguments. Nicastro says that there is some element of skill in the bonus game. This is what he is arguing. It appears as if he is right.

Not only is this concept taught by Nicastro (& Tulley for that matter), but it is notoriously well known in the art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

All claims are respectfully rejected.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tulley et al. (US 7,179,168 B1) in view of Nicastro (US 2003/0027619 A1).

Regarding claims 1,6 & 11, Tulley discloses a system and method for allocating an outcome amount among a total number of events (Title), wherein a central server (410) generates a game result using a fixed-pool of elements, each element corresponding to a game play result (col. 7, lines 42-45). There is a player terminal (302) in operable communication with the central server. (Fig 4) The player terminal is configured to send game play requests to said central server and receive game play results from said central server (col. 8, lines 42-50). The player terminal is further configured to determine a base game play result and a secondary game play result from a single game play result received from the central server. (See the example in Col. 10. Lines 10-64 where the player plays a slot game followed by a maze game to reveal the predetermined outcome). Tulley reverse-maps the base game play result into a display such that the display shows game indicia has a value corresponding to the base game play result. Tulley also shows secondary game indicia that are different from the base game play display. These secondary game indicia have a value corresponding to the secondary game play result. The single game play result is a fixed sum that is awarded to the player. (See the example of the slot game followed by a maze game in Col. 10. Lines 10-64; the games are different, use different symbols & show results such as a slot & maze game results.)

Tulley discloses an embodiment of the invention in col. 10, lines 10-65 wherein a player purchases $5.00 worth of events from a gaming service and the gaming service

determines the player's total event outcome will total $8.00, i.e. the player will win a total prize of $8.00, to be awarded in a series of events. The player chooses to play a base slot-machine type game, wherein a portion of the total event outcome is awarded to the player. The player then chooses to play a secondary game having different indicia from the base game, and the remainder of the total event outcome is then awarded to the player. The manner in which the game outcomes are displayed to the player are determined by the total outcome amount, i.e. the total outcome amount is reverse-mapped into a series of displays.

Tulley does not specifically disclose the player terminal is configured to determine a base game play result and a bonus game play result from a single game play result.

Nicastro quoted in part below teaches:

"Those skilled in the art will appreciate that many variations on the basic game and bonus game describe herein are possible in keeping with the spirit and scope of the present invention. The particular graphical elements can be arranged differently or have a different appearance. The overall game theme can be a different, such as hound and hare rather than cat and mouse. The basic game can be any video game offering a winning combination that earns a bonus game entry combination, such as a video slot machine game, video poker, video blackjack, video keno, or the like." See ¶0085.

Thus, bonus games not requiring additional wagers are taught.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide bonus games as taught by Nicastro into Tulley's slot & video poker games. Such a modification is viewed as a substitution of known elements (bonus games into slot & video poker games) with the predictable results of attracting players; bonus games give players the sense that something is being given away for nothing. They attract players. They provide the sense that there exists one-more-chance to win.

Regarding claims 2, 3, 7, 8, 12 & 13, Tulley discloses a secondary game indicia comprises a plurality of indicia wherein said plurality of indicia is selectable and where said result is divided into a set of partial win results that, in total, are an amount equal to said results, and wherein said partial win results are awarded one at a time as a result of selectable indicia being selected until all of said partial win results are awarded (col. 10, lines 42-55), as the player selects a plurality of boxes each box containing a portion of the total win outcome.

Regarding claims 4, 9 &14, Tulley discloses the use of an indicator recognizable by said player terminal to indicate a game play result (col. 10, lines 20-24).

Regarding claims 5,10 & 15, Tulley discloses the secondary game play amount is calculated by subtracting a known base game amount from said game play result (col. 10, lines 47-55), wherein the amount won by the player in the base game is subtracted from the total winning amount to obtain the amount to be won in the secondary game.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OAD/